

REMARKS

Claims 1-13 and 17-19 are pending in the present application. Claim 1 has been amended as a result of Response. Claims 1, 17, and 19 are independent claims.

ELECTION/RESTRICTION

The Examiner maintains the Restriction Requirement based on undue burden, citing MPEP §803. The Examiner asserts that since she has shown that the different groups retain separate classification, separate status in the art, and different field of search, restriction is proper.

Applicants direct the Examiner's attention to MPEP § 806.05(c), which states that to support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification status or field of search. See MPEP §808.02. The inventions are distinct if it can be shown that a combination as claimed:

"A) does not require the particulars of the sub-combinations as claimed for patentability (to show novelty of unobviousness), and

B) the subcombination can be shown to have utility either by itself or in other and different relations.

When these factors can not be shown, some inventions such inventions are not distinct.

Although the Examiner has apparently shown reasons for insisting on restriction (serious burden), the Examiner has not established two-way distinctness. In particular, the Examiner has not set forth part B) above. In particular, part B) recites that the sub-combination can be shown to have utility either by itself or in different relations. Claims 12-13 and 16 cannot be shown to have utility, either by themselves or in other different relations, because they depend from

independent claim 1. As a result, part B) of the above test is not met and the Examiner's restriction must be withdrawn.

The Examiner's arguments that the apparatus of invention II can be used to practice another materially different process, such "a plurality of drinking cups with orange juice, an ice cube tray with wells containing water, or test strip with several test over areas impregnated with reagents" is impossible because claim 12-13 and 16 depend from independent claim 1 which does not recite any of these features.

Applicants assert that the Examiner's argument might be true if the subject matter of claims 12-13 and 16 were separate independent claims, however, this is not the case and each of claims 12-13 and 16 depend from independent claim 1, which does not include these features. Accordingly, reconsideration and withdrawal of the Restriction is respectfully requested for this additional reason.

At the very least, Applicants respectfully request rejoinder of claim 12-13 and 16 upon allowance of independent claim 1.

With respect to claim 17-19, Applicants respectfully assert that these claims are linking claims which link the method and kit claims (independent claim 17) and the method and computer readable data carrier (independent claim 19), respectively. Accordingly, Applicants respectfully request consideration and allowance of claim 17-19 under MPEP § 809.03, in the event that independent claim 1 is found allowable.

PRIORITY

Applicants acknowledge the Examiner's request for Applicants to perfect the claim for priority. Applicants are in the process of obtaining a certified copy of PA 200 00759 filed in Denmark on May 8, 2000.

INFORMATION DISCLOSURE STATEMENT

The Examiner reminds Applicants that the last IDS filed is not present in the Examiner's file. Applicants respectfully assert that the USPTO's own PAIR system indicates that Applicants Information Disclosure Statement of November 1, 2001 was received and logged by the USPTO office as Paper Number 10 on January 15, 2002. Applicants have enclosed a copy of the Information Disclosure Statement filed on November 1, 2001, including the PTO- 1449 and all references listed therein. Consideration of these publications is respectfully requested.

35 U.S.C. § 102(B) NOVA REJECTION

Claims 1-11 have been rejected under 35 U.S.C. §102(b) as being anticipated by WO 98/15825 to Nova et al. This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed for the following reasons.

Applicants respectfully assert that Nova teaches that the user enters the names of the chemical building blocks, which may correspond to the user providing information regarding the functionality in the chemical species of independent claim 1. Applicants further respectfully submit that Nova discloses that the user optionally enters "recipe information" such as reaction times, temperatures, molarities, etc.

However, Applicants respectfully assert that in Nova the recipe information is 1) not selected via a parameter selection unit and 2) based on the information about the desired transformation, both of which are clearly recited in independent claim 1. Accordingly, Applicants respectfully submit that independent claim 1 is allowable for at least this reason. Applicants respectfully submit that dependent claims 2-11 are allowable by virtue of their dependency on allowable independent claim 1, for at least the reasons set forth above.

DOUBLE PATENTING REJECTION

The Examiner has objected to claim 4 under 37 CFR 1.75 as being a substantial duplicate of claim 3. In contrast, Applicants respectfully assert that dependent claim 3 recites that the R sets of reaction parameters involve the use of more than one (1, 2, 3, ... $R-1$, R , $R+1$...) chemical substance A_R . In contrast, in independent claim 4, each of the \underline{R} sets of reaction parameters involves R chemical substances, not a number other than R . Accordingly, Applicants respectfully submit that claims 3 and 4 differ, and therefore, a double patenting rejection is inappropriate.

CONCLUSION

In view of the above amendments and remarks, reconsideration of the various objections and rejections and allowance of each of claims 1-13 and 17-19 is respectfully requested.


Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John A. Castellano at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKY, & PIERCE, P.L.C.

By



John A. Castellano, Reg. No. 35,094
P.O. Box 8910
Reston, Virginia 20195
(703) 668-8000

JAC/cah

Enclosures: 11/1/01 IDS including PTO-1449 and references
PAIR